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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/287,664	04/07/99	RUSSO	D 01222.0034-0

IM62/1031
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WASHINGTON, DC 20005-3315

EXAMINER

BRUNSMAN, D

ART UNIT	PAPER NUMBER
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1755

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DATE MAILED: 10/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/287,664

Applicant(s)

Russo et al

Examiner

David M. Brunzman

Group Art Unit

1755



☒ Responsive to communication(s) filed on 13 Jun 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-32 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-27 is/are allowed.

☒ Claim(s) 28-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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The rejections under 35 U.S.C. 251 for a defective reissue oath and obviousness type double patenting are withdrawn in view of applicant's response. New rejections under recapture and over prior art follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28, 29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4880664.

The patent abstract teaches a CVD source material comprising a tin oxide precursor and water.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4880664, as applied above, in view of US Patent 4308316..

Claim 30 further requires the process "comprise" a precursor for silicon oxide. US Patent 4308316 teaches addition of a silicon oxide precursor to CVD source materials to form metal oxide films having selected refractive indices. See also, example 4. It would have been

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obvious to one of ordinary skill in the art to use a combination of tin oxide precursor and silicon oxide precursor because US 4308316 teaches films having intermediate refractive indices that may be used to prevent iridescence may be may therefrom.

Claims 28-32 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In the prosecution history of this application, broad claims to a process of forming an oxide composition were originally filed in US application serial number 07/814352. That application was restricted to process claims. The examiner made a rejection over prior art on those process claims. Subsequently, applicant filed a PCT application, PCT/US92/10872 claiming priority from 07/814352 and designating the US. The claims filed in the PCT application and the national stage under rule 371 in US application 08/104124 were narrowed to require in the first instance: at least 1) a tin oxide precursor, 2) a silicon oxide precursor, 3) an accelerant selected from organic phosphites, organic borates and water, 4) a glass substrate and, 5) a deposition rate of at least 350 angstroms/second; or in the second instance: at least 1) a tin oxide precursor, 2) a silicon oxide precursor, 3) an accelerant selected from boron and phosphorous esters and water, 4) a glass substrate and, 5) a deposition rate of at least 400 angstroms/second; apparently in response to the rejection made in 07/814352.


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In accordance with the prosecution history of and rejections made in 08/544212, claims requiring a deposition rate of at least 350 angstroms/second or greater, require that the source material be comprised of a tin oxide precursor, the particular silicon oxide precursors of instant claims 1 and 23, and an accelerant selected from organic phosphites, organic borates, water, boron esters and phosphorous esters; in order to comply with the requirements of 35 U.S.C. 112, 1st paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunzman whose telephone number is (703) 308-3454. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays from 6:30 am to 5:00 pm eastern time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

DMBrunzman
October 27, 2000



David M. Brunzman
Primary Examiner
Group 1755